

REMARKS

Claims 1-78 are pending in the Application. Claims 27-38 are withdrawn from consideration. Claims 1-13, 15-26, 39-41, 44-47, 50, and 54-78 currently stand rejected. Claims 14, 42, 43, 48, 49, and 51-53 are objected to as being dependent upon a rejected base Claim, but would be allowable if rewritten in independent form including all the limitations of the base Claim and any intervening Claims. Reconsideration of the Application in view of the Amendments and Response is respectfully requested.

RESPONSE

35 U.S.C. §102

In paragraph 5 of the Office Action, the Examiner rejects Claim 39, 41 under 35 U.S.C. § 102(e) as being anticipated by US2003/0175494 (hereafter Penneau). The Examiner asserts that in Penneau, example 1 discloses dry processed particles. Applicants traverse the Examiner's assertion and direct the Examiner to paragraph [0132] where it is taught that water is used during a process of making a film. The Examiner's burden under a 35 U.S.C. § 102(e) rejection requires that all claim limitations be identically disclosed by the prior art. If the Examiner wishes to maintain his rejection of Claim 39, Applicants respectfully request that he provide clarification where in Penneau Applicants' "dry processed particles including recycled binder and conductive particles" are taught or suggested. For at least the reasons stated above, and others stated

below, the Examiner's rejection of Claim 39 fails, and Applicants respectfully request allowance of independent Claim 39 so that the present Application may issue in a timely manner.

In paragraph 4 of the Office Action, the Examiner rejects Claims 1-8, 10-13,
5 18-26, 39-40, 46, 54-62, 64-73, 75, and 78 under 35 U.S.C. § 102(b) as being anticipated by USPN 6,614,646 (hereafter Bogaki).

Regarding independent Claim 21, the Examiner states Bogaki discloses "an energy storage product, comprising: a dry mix of dry binder and dry carbon particles, the particles formed into a continuous self-supporting electrode film
10 without the substantial use of any processing additives (see col. 4 lines 11-13 – discloses a lubricant may be added to the mixture (not required)). The mix (being formed from a dry process) would be "recyclable." Applicants traverse the Examiner's rejection; Applicants direct the Examiner to examples 1-3 in Bogaki, wherein it is described that prior to kneading, particles are mixed with water (i.e.
15 a wet process). Examples 1-3 in Bogaki, therefore, teach that water is used and, as well, according to col. 4 lines 11-13, that "liquid lubricant may be added." Unlike Bogaki, Applicants teach extensively throughout their Specification an enabling process that does not use any solvent, lubricants, or other liquids and that, for at least this reason, impurities and residues associated therewith do not
20 degrade the quality of the dry particles 12, 14, 16, 21, and/or 23, thus, allowing the particles to be reused one or more times. None of Applicants' teachings are suggested or taught by Bogaki or any other reference cited by the Examiner. The Examiner's burden under a 35 U.S.C. § 102(b) rejection requires that all claim

limitations be identically disclosed by the prior art. Bogaki fails to teach “recyclable dry binder and dry carbon ...formed ... without the substantial use of any processing additive.” For at least these reasons, and for further reasons stated below, the Examiner’s rejection fails, and Applicants respectfully request
5 allowance of independent Claim 21 so that the present Application may issue in a timely manner.

Regarding independent Claims 4, 39, 54, 59, and 69, the Examiner further cites Stephens, Wenzl and Browne, 145 USPQ 656 (CCPA 1965) for the proposition that a “method of forming a device is not germane to the issue of
10 patentability of the device.” Applicants traverse the Examiner’s rejection under this rationale. If the Examiner wishes to maintain his rejection, Applicants respectfully request that the Examiner provide further clarification as to where he has understood that a “method of forming” has been claimed by the Applicants. In Claim 54 the limitation of “reused,” and in Claims 4, 39, 59, and 69 the
15 limitation “recycled,” describes a property of particles, not a method; such can be clearly understood from the grammatical use of these limiting adjectives in Claims 4, 39, 54, 59, and 69. Even assuming arguendo that Applicants’ claimed limitation of “recycled” or “reused” is a method of forming, the Examiner is directed to In re Luck, 476 F.2d 650, 177 USPQ 523 (C.C.P.A. 1973) a later and
20 governing case in which the CCPA clearly held that process limitations are to be considered in a product claim to patentably distinguish the product of the prior art. Other subsequent cases have held the same as Luck (see In re. Wertheim, 541 F.2d 257, 191 USPQ 90, 102 (C.C.P.A 1976).

Further regarding independent Claim 54, the Examiner asserts that in col. 4 lines 8-11 of Bogaki, Applicants' claimed "about zero parts per million processing additive" limitation is taught. Applicants traverse the Examiner's rejection. The Examiner's burden under a 35 U.S.C. § 102(b) rejection requires that all claim limitations be identically disclosed by the prior art. All that is taught in col. 4 lines 8-11 of Bogaki is that "liquid lubricant may be added." Applicants are unclear as how col. 4 lines 8-11 teach the limitations of Claim 54. Further clarification is respectfully requested.

Regarding independent Claims 1, 64, and 65 the Examiner states the mix ... (being formed from a dry process) would be "recyclable". Applicants traverse the Examiner's rejection and incorporate by reference Applicants' response above, and further state that the mere assertion by the Examiner that Bogaki teaches "recyclable" particles is insufficient. The Examiner's burden under a 35 U.S.C. § 102(b) rejection requires that all claim limitations be identically disclosed by the prior art. If the Examiner wishes to maintain his rejection of Claims 1, 64, and 65, Applicants respectfully request that he provide clarification where in Bokagi "recyclable" particles are taught or suggested. For at least these reasons, the Examiner's rejection fails, and Applicants respectfully request allowance of independent Claims 1, 4, 21, 39, 54, 59, 64, 65, and 69 so that the present Application may issue in a timely manner.

Regarding independent Claim 75, the Examiner appears to assert that the claimed features of Claim 75 are inherent in that which is taught by Bogaki. Applicants traverse the Examiner's rejection and incorporate by reference

Applicants' responses above. As discussed above, Bogaki discloses the use of water (processing additive). In the context of Claim 75, Bogaki would thus be compared against an "electrode ... processed with a processing additive." In other words, according to the comparison made by Claim 75, Bogaki would teach the
5 same amount of residue, not "less residue." Therefore, Bogaki fails to teach Applicants' claimed "recyclable ... "less residue." The mere assertion by the Examiner that Applicants claims are taught is insufficient. The Examiner's burden under a 35 U.S.C. § 102(b) rejection requires that all claim limitations be identically disclosed by the prior art. For at least the above reasons, the
10 Examiner's rejection fails, and Applicants respectfully request allowance of independent Claims 1, 4, 21, 39, 54, 59, 64, 65, 69, and 75 so that the present Application may issue in a timely manner.

Regarding independent Claim 78, Applicants' responses above are incorporated by reference. The mere assertion by the Examiner that Applicants'
15 claims are taught is insufficient. The Examiner's burden under a 35 U.S.C. § 102(b) rejection requires that all claim limitations be identically disclosed by the prior art. If the Examiner wishes to maintain his rejection of Claim 78, Applicants respectfully request that he provide clarification where in Bogaki "recyclable electrode means" are taught or suggested. For at least the reasons
20 stated above, the Examiner's rejection fails, and Applicants respectfully request allowance of independent Claims 1, 4, 21, 39, 54, 59, 64, 65, 69, 75, and 78 so that the present Application may issue in a timely manner.

In paragraph 6 of the Office Action, the Examiner rejects Claim 50 under

35 U.S.C. § 102(e) as being anticipated by USPN 6,912,116 (hereafter Takahashi).
Regarding independent Claim 50, the Examiner appears to assert that the
claimed features of Claim 50 are inherent in that which is taught by Takahashi.
Applicants traverse the Examiner's rejection, incorporate by reference Applicants'
5 responses above, and further state that the mere assertion by the Examiner that
Takahashi teaches that Applicants' particles would be "reusable" is insufficient.
The Examiner appears to be asserting that particles 231 in Takahashi are
reusable. As described throughout in Takahashi, solvents, etc are intentionally
used (see example 1). The intentional usage of solvents teaches away from the
10 reuse of electrode materials, which as described by Applicants in their
Specification, are preferably substantially free of such solvents. Thus, with
reference to "reusable" particles, Applicants' invention is not taught or suggested.
The Examiner's burden under a 35 U.S.C. § 102(e) rejection requires that all
claim limitations be identically disclosed by the prior art. If the Examiner wishes
15 to maintain his rejection of Claim 50, Applicants respectfully request that he
provide clarification where in Takahashi "reusable" particles are taught or
suggested. For at least the reasons stated above, the Examiner's rejection fails,
and Applicants respectfully request allowance of independent Claims 1, 4, 21, 39,
50, 54, 59, 64, 65, 69, 75, and 78 so that the present Application may issue in a
20 timely manner.

Regarding dependent Claims 2-3, 5-8, 10-13, 18-20, 22-26, 40, 41, 46, 55-
58, 60-62, 66-68, 70-73, these claims depend from one or more allowable claim,
and for at least this reason are also allowable. Applicants therefore respectfully

request allowance of Claims 1-8, 10-13, 18-26, 39-40, 46, 54-62, 64-73, 75, and 78 so that the present Application may issue in a timely manner.

35 U.S.C. §103

5 In paragraph 9, Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bogaki in view of by US 2003/0030963 (hereafter Tennet).

 In paragraph 10, Claims 44-45 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bogaki.

10 In paragraph 11, Claim 63 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bogaki in view of by US 2002/0096661 (hereafter Shinozaki).

 In paragraph 12, Claims 76 and 77 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bogaki in view of JP 4-88619.

 In paragraph 13, Claim 74 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bogaki in view of US 5,706,165 (hereafter Saito).

15 The Examiner's burden is to establish a prima case of obviousness under 35 U.S.C. § 103(a). As per MPEP § 2142, " ... the prior art reference (or references when combined) must teach or suggest all the claim limitations." The mere assertion by the Examiner that references can be modified or combined does not make it so, and is insufficient to establish a *prima facie* case of obviousness.

20 Moreover, the mere fact that the modification or combination would be well within the ordinary skill in the art, by itself, is insufficient to establish a *prima facie* case of obviousness. The Examiner has the burden to show the additional step of how the knowledge of the skilled artisan leads to the suggestion or motivation. As

well, the suggestion or motivation can only come from the art that existed at a time prior to the invention and cannot come from the invention itself.

For at least these reasons, Applicants traverse the rejections under 35 U.S.C. § 103(a) and, as well, because Claims 9, 44-45, 63, 74 76, and 77 depend from allowable claims that fail to be taught by the prior, Applicants respectfully request allowance of all presently rejected independent and dependent claims.

Allowable Subject Matter

The Examiner has indicated that Claims 14, 42-43, 48-49, 51-53 are objected to but would be allowable if rewritten in independent form including all if the limitation of the base claim and any intervening base claims. Accordingly, Claims 14, 42, 48, 51, and 53 are amended; allowance of Claims 14, 42-43, 48-49, and 51-53 is respectfully requested.

Summary

Applicants submit that the foregoing remarks overcome the Examiner's objection, and rejections. Because the cited references and the Examiner's citations thereto do not identically teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicants submit that the claimed invention is patentable over the cited art, and respectfully request that the Examiner allow all presently pending Claims. If there are any questions concerning this Amendment, the Examiner is invited to .

contact the Applicants' undersigned representative at the number provided below.

5

Respectfully submitted,

Date:

7 Nov 05

By:



Mark Wardas, Reg. No. 37,961
Maxwell Technologies, Inc.
9244 Balboa Ave. San Diego 92123
(858)-503-3445

10